

REMARKS

Reconsideration of this application in view of the above amendments and the remarks below is respectfully requested. Claims 1, 23, 24, 26-28, 30, and 31 are amended herein. Claims 20-22 are cancelled. No claims are added. Hence, Claims 1-13, 15-19, and 23, 24, 26-28, 30, and 31 are pending.

I. ISSUES NOT RELATED TO CITED REFERENCES

A. RESTRICTION REQUIREMENT

The Office Action maintains a previously issued restriction requirement. The Office Action reasserts a serious burden in examining the original Claims 13 and 14 and provides no evidence as to why allegedly different searches with respect to the original Claims 13 and 14 lead to the serious burden. Applicant reserves the right to challenge the restriction requirement with respect to the original Claims 13 and 14.

B. OBJECTION TO THE SPECIFICATION

Applicant's specification was objected to because of informality. Accordingly, Applicant's specification has been amended. Removal of this objection is respectfully requested.

The Office Action advised that Claims 5 and 6, when combined with Claim 1, may be substantially duplicative to Claims 20 and 22. Accordingly, Claims 20 and 22 have been canceled.

C. 35 USC 112, SECOND PARAGRAPH

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite. Applicant believes that the claim as written is not contradictory between the features cited therein. For example, since a certificate issuance featured in Claim 28 may involve two stages -- one from an issuer to a merchant and the other from the merchant to a recipient -- it is not contradictory that the merchant may also perform a step of "issuing and activating". To further

advance prosecution, however, Claim 28 has been amended to refer to “issuing to the recipient” by the merchant. The removal of this rejection is respectfully requested.

II. ISSUES RELATED TO CITED REFERENCES

A. 35 USC 102(e) – *VAN DUSEN*

Claims 1, 2, 4, 7-8, 10, 20, 23, 24, and 26-28 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by Van Dusen, U.S. Patent No. 6,175,823 B1 (hereinafter *Van Dusen*). Applicant has canceled Claim 20, and amended claims 1, 23, 24, and 26-28 to claim the invention more distinctly. Applicant submits that the pending claims, as amended, are patentable over the art of record. Each pending claim is discussed below.

Claim 1

Present Claim 1 recites, among other things:

storing an initial face value of the electronic stored value certificate,
determining a new face value by reducing the initial face value of the electronic
stored value certificate by a portion of the initial face value in response to
receiving information indicating redemption at the merchant of the portion
of the initial face value for goods or services, and
storing the new face value of the electronic stored value certificate;
**repeating the steps of determining and storing the new face value in response
to successively received redemption information until the new face
value of the electronic stored value certificate is zero** (emphasis added).

Claim 1 provides a way for issuing to a recipient an electronic stored value certificate. Under this approach, the certificate may be redeemed one or more times at a merchant for goods and services, while the value of the certificate is updated and tracked until the value is zero.

According to Claim 1, as part of activating the electronic stored value certificate, a unique identification value is created and stored in association with received certificate information (including, for example, recipient information and an initial face value). When redemption of a portion of the initial face value at a merchant is indicated, a new face value of the electronic

stored value certificate may be determined by reducing the initial face value by the portion indicated to be redeemed. This new face value is stored so that redemption may be repeated until the electronic store value certificate is used up its value (i.e., when its value is zero).

Such an approach under Claim 1 is not disclosed by *Van Dusen*. Instead, *Van Dusen* discloses a method of issuing and using electronic gift certificates in the form of an email. As disclosed, the certificates in *Van Dusen* are primarily used to credit recipients' accounts with the issuing merchant. Specifically, nothing in *Van Dusen* discloses that the electronic gift certificate's value is continuously updated, tracked and may be repeatedly used until its value is zero, as the recited features of Claim 1 require.

As disclosed in *Van Dusen*, in creating the email that represents the certificate, a decision block (98) is used to determine whether the recipient has an account with the merchant. If so, the email embeds a link for the recipient to automatically redeem the certificate (i.e., credit the recipient's account with the issuing merchant). If not, the email embeds a different link for the recipient to first set up an account with the merchant.

FIG. 6 of *Van Dusen* (steps 114 and 116) further illustrates a process of automatic redemption when the recipient receives the electronic gift certificate in its email. As disclosed, once the recipient's account with the merchant is credited by the certificate amount, the **certificate's entry is deleted** (i.e., it cannot be used the second time). Thus, based on the logical flow as illustrated by FIG. 6, the redemption of the electronic gift certificate happens only once in *Van Dusen*.

For the reasons set forth, since *Van Dusen* fails to disclose each and every feature of Claim 1 including those recited above, it is respectfully submitted that Claim 1 is patentable over *Van Dusen*.

Claims 23, 24, and 26-28

Independent Claims 23, 24, and 26-28 each recite similar features as those discussed above with respect to Claim 1. Consequently, it is respectfully submitted that Claims 23, 24, and 26-28 are patentable for at least the same reasons discussed above as to Claim 1.

Claims 2, 4, 7-8, and 10

Each of dependent Claims 2, 4, 7-8, and 10 contains all the features of Claim 1, 23, 24, and 26-28 discussed above and is patentable for the same reasons discussed above with respect to Claim 1, 23, 24, and 26-28. Further, dependent Claims 2, 4, 7-8, and 10 contain features that individually render them patentable. Due to the fundamental differences already identified, a separate discussion of those features is not included at this time. For all the foregoing reasons, Applicants respectfully submit that Claims 2, 4, 7-8, and 10 are allowable over *Van Dusen*.

B. 35 USC 103(a) – *VAN DUSEN* AND OFFICIAL NOTICES

Claims 3, 5, 6, 9, 11-13, 15-19, 21, 22, 30 and 31 were rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Van Dusen*, in view of Official Notices. Applicant has canceled Claims 21 and 22, and amended Claims 30 and 31 to claim the invention more distinctly. Applicant submits that the pending claims, as amended, are patentable over the art of record. Each pending claim is discussed below.

Claims 30 and 31

Independent Claims 30 and 31 each recite similar features as those discussed above with respect to Claim 1. The Official Notice (i.e., a merchant may contract a third party to perform issuing certificates for reasons of efficiency) taken against Claims 31 and 32, even if true, is irrelevant to the above discussed features of Claim 1 that are missing in *Van Dusen*. Consequently, it is respectfully submitted that Claims 30 and 31 are patentable for at least the same reasons discussed above as to Claim 1.

Claims 3, 5, 6, 9, 11-13, and 15-19

Each of dependent Claims 3, 5, 6, 9, 11-13, and 15-19 contains all the features of Claim 1, 23, 24, and 26-28 discussed above and is patentable for the same reasons discussed above with respect to Claim 1, 23, 24, and 26-28. Further, dependent Claims 3, 5, 6, 9, 11-13, and 15-19 contain features that individually render them patentable. Due to the fundamental differences already identified, a separate discussion of those features is not included at this time. For all the foregoing reasons, Applicants respectfully submit that Claims 3, 5, 6, 9, 11-13, and 15-19 are allowable over *Van Dusen* in view of Official Notices.

III. CONCLUSIONS & MISCELLANEOUS

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on 6/21/07 by Martina Placid
Martina Placid